



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,332	06/20/2003	Ubaldo Mastromatteo	2110-46-3	6985

7590 07/12/2005
GRAYBEAL JACKSON HALEY LLP
Suite 350
155-108th Avenue N.E.
Bellevue, WA 98004-5973

EXAMINER

HEINZ, ALLEN J

ART UNIT PAPER NUMBER

2653

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,332	Applicant(s) MASTROMATTEO ET AL.	
	Examiner A. J. HEINZ	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 and 23-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2653

1. Applicant's election with traverse of the Group II invention[Cls.1-9,17-22] in Paper dated 4/7/05 is acknowledged.

Claims 10-16,23-39 have been withdrawn from further consideration by the examiner, pursuant 37 CFR 1.142(b), as being drawn to the non-elected invention, the requirement having been traversed in Paper dated 4/7/05.

The traversal is on the ground(s) that because there is sufficient commonality in the subject of both the apparatus and method claims there is no significant burden for the examiner to examine both inventions. This is not found to be persuasive because the applicant has failed to provide substantive evidence showing, for example, that searching the additional varied and complex processes such as coating and/or cutting classified in class 29, when it is not required for the apparatus, would not place a greater burden upon the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of Claim 20 must be

Art Unit: 2653

shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The Title should provide a more detailed structural identification of the feature or features which distinguish the invention from the prior art. The intended results produced by the structural differences can also be part of the content of the Title.

The portion of the Title directed to the method should be deleted.

4. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or

Art Unit: 2653

improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(C) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP §608.01(o). Correction of the following is required: Cls.1-9,17-22 contains terminology which fails to find support in the specification; i.e. "first" or "second biasing region".

5. Claims 1-9,17-22 are rejected under 35 U.S.C. §112, first paragraph, as directed to subject matter which was not described in the specification in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. See previous paragraph.

Art Unit: 2653

6. Claims 1-9,17-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1&3 are incomplete because they reference structure which has not been clearly identified; i.e. Claim 1, line 11, "at least one" (what feature or structure is 'one' referencing?). Likewise for claims 3, line 3.

The instant claims appear to be claiming structure which relies on a frame of reference which has not been clearly established, and/or the terminology used to define same lacks clear antecedent basis within the claim(claims); i.e. either the particularly recited passage fails to be properly introduced prior to its appearance at that point in the claim or the structure recited in the passage is not an inherent part of or component of other previously recited structure: i)"the entire thickness"(Cl.3, line 2, i.e. the body has not been defined to either have a thickness nor does the currently claimed structure of the body inherently have a dimension which one of ordinary skill in the art would automatically denote as being a thickness); and ii)"extending through the fixed portion"(Cl.17, line 11, Cls.21&22, lines 14-15; e.g. does the fixed portion have a thickness or some dimension which supports that the

Art Unit: 2653

insulating material can be configured to insulate the first biasing region).

In Cls.21&22, line 8, the instant claims are ambiguous because the passage "fixed portion having a fixed portion" is attempting to define two features with the same term.

An exhaustive search of indefinite and/or ambiguous language has not been attempted, but only exemplified in the preceding paragraphs. Therefore the applicant is responsible for a thorough review of all the claims to make corrections as appropriate.

7. No prior art rejections have been attempted in this instant office action because the nature and breath of the indefiniteness and omissions in the specification do not permit a sufficient understanding of scope of the claimed invention.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vigna(PN's 6404599, 6624981, 6809907), Murari, Bonin(PN's 6683757,6798609,6731471) and Boutaghou show various microactuators.

Art Unit: 2653

9. For a complete response applicant should identify how the claimed structure of his invention defines over **all** the art of record.

Moreover, where the applicant disagrees with the reasoning and/or application of the prior art on critical points of the claims, they should identify how the claimed structure of their invention defines over **all** the art of record not just the applied art.

Where applicant believes that the art is redundant and/or superfluous relative to the critical aspects of the claimed invention the applicant may simply state so in rebuttal summary.

10. If applicant has filed an information disclosure statement and has not received an office action that contain an initialed-off copy (or copies) of all such filed IDS's (or at least a comment to the disposition of such IDS'S in the body of the office action itself) applicant should apprise the examiner of such missing documentation [to the IDS's] in response to this office action so that the examiner can take appropriate action to supply same to the applicant.

Art Unit: 2653

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. J. HEINZ whose telephone number is (571) 272-7587. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM KORZUCH can be reached on (571)272-7589.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. J. HEINZ
Primary Examiner
Art Unit 2653

A handwritten signature in cursive script, appearing to read "A. J. Heinz", written in black ink.